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**NEW YORK, NY 10017-5612**

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**MAR 08 2005**

**OFFICE OF PETITIONS**

In re Application of :  
Timothy J. N. Watson et al :  
Application No. 10/706,694 :  
Filed: November 12, 2003 : **ON PETITION**  
Attorney Docket No. PC23299A :  
For: METHOD FOR PREPARING INDAN-1,3- :  
DICARBOXYLIC ACID :

This is a decision on the petition under 37 CFR 1.137(b), to revive the above-identified application and on the petition under 37 CFR 1.47(a), filed November 8, 2004.

The petitions are **DISMISSED**.

Any request for reconsideration must be submitted within TWO MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any reply should be entitled "Renewed Petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a)" and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the nonsigning inventor. This is **not** a final agency action within the meaning of 5 U.S.C. §704.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.17(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(c) and (D). The instant petition lacks item (1) since the application cannot be revived until such time as a grantable petition under 37 CFR 1.47(a) has been received.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

Applicant lacks item (1) set forth above.

As to item (1), the applicable statute (35 USC 116) requires that a "diligent effort" have been expended in attempting to find or reach the nonsigning inventor. See MPEP 409.03(a). The showing currently fails to demonstrate, with a documented showing, that a diligent effort was made to find or locate the nonsigning inventor, such that the declaration can be accepted under 37 CFR 1.47(a).

Where inability to find or locate a named inventor(s) is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor. The statement(s) of fact must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay, will not normally be accepted.

In the instant case, while petitioner has indicated that a request was made on February 28, 2004, March 24, 2004, and September 30, 2004, petitioner has not indicated whether he has attempted other means to locate the inventor, i.e., the telephone directory for the greater Quebec area, E-mail, the internet, or Lexis. Copies of the results of the search must be referred to in any renewed petition. See MPEP 409.03(d). If inventor Mr. Patrice Arpin is located, then a copy of the transmittal letter itemizing the complete application papers, as well as a copy of the proof of service on inventor Mr. Arpin will be required. A cover letter of instructions should accompany the mailing of application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct.

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration by the party to whom the refusal was made. Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the rule 47 applicant that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever an omitted inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                Mail Stop PETITIONS  
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                          Alexandria, VA 22314

By fax:                (703) 872-9306  
                          ATTN: Office of Petitions

Telephone inquiries related to this decision should be directed to Wan Laymon at (571) 272-3220.

A handwritten signature in cursive script, reading "Frances Hicks".

Frances Hicks  
Lead Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy